

## REMARKS/ARGUMENTS

### Amendments

The amendments to the claims are supported throughout the specification, and, more particularly, in Examples 1 and 2, where specific constructs and transformation methods are provided.

### Rejections under 35 U.S.C. § 101

Applicants have amended Claims 8 and 15 such that the claims no longer recite the phrase "under selective conditions". The amendment suggested by the Examiner has been adopted, namely, to limit the progeny to "transformed progeny".

For this reason, it is believed that the rejection under this provision should be obviated, and withdrawal of the rejection is respectfully requested.

### Rejections under 35 U.S.C. § 112, ¶ 2

Claims 8 and 15 also stand rejected for indefiniteness. The amendment suggested by the Examiner to the claims has also been adopted for this rejection, namely, to eliminate the phrase "under selective conditions".

As this rejection should be obviated by the above amendments, withdrawal of the rejection is respectfully requested.

### Rejections under 35 U.S.C. § 112, ¶ 1 - Written Description

Claims 6 and 13 stand rejected for claiming a "modified" EPSPS gene.

While Applicants submit that the specification adequately teaches the use of several such modified genes, for purposes of better clarity and to advance prosecution the claims have been amended by the cancellation of the term "modified".

The claims now simply amend the previous claim's 5-enolpyruvylshikimate-3-phosphate synthase (EPSPS) gene limitation by adding that the gene is one "which encodes an enzyme that confers resistance to the herbicide glyphosate." Such genes are described in the application, particularly on page 8 of the specification. The skilled artisan would require nothing more than use of any one of the EPSPS genes provided in this description to be in possession of the gene of that limitation, and to thereby practice the invention as claimed.

It is submitted that the amendments to Claims 6 and 13 obviate the rejection of this provision, and withdrawal of the rejection is therefore respectfully requested

Rejections under 35 U.S.C. § 112, ¶ 2 - Enablement

Claims 1 3-9 and 11-15 stand rejected for failing to comply with the enablement requirement.

Applicants believe that the rejection to the claims under this provision should be obviated in view of the attached declaration prepared according to 37 C.F.R. § 1.132, submitting evidence by declaration that the methods as described in the examples have been used to produce the claimed invention.

As the claims, as amended, have been clearly enabled by the specification, as evidenced by the declaration supporting the use of the methods to practice the invention, Applicants respectfully request that the 1st paragraph rejections under this section be reconsidered and withdrawn.

Rejections under 35 U.S.C § 102 – Dommissee et al.

Claims 8 and 15 stand rejected over Dommissee et al. This rejection is respectfully traversed for the reason that the amended claims now recite an *Allium* plant or plant tissue transformed by the method or transformed progeny thereof containing the DNA of interest.

While Dommissee *et al.* may provide an early report of the susceptibility of *Allium* to *Agrobacterium* infection, it does not disclose that plants may be obtained transformed in the manner claimed. Such plants are easily distinguishable from an *Allium* plant transformed by the method of Dommissee et al.. One skilled in the art could employ any of various means known for detecting a heterologous gene in a transformed plant.

Based on the foregoing amendments and remarks, Applicants request that the examiner reconsider and withdraw his rejection of claims 2-6 under 35 U.S.C. § 102.

Rejections under 35 U.S.C § 103 –Eady *et al* (1) in view of Eady *et al* (2)

Claims 1, 3-9 and 11-15 are rejected as being obvious under the combination Eady *et al* (1) and Eady *et al* (2). This rejection is respectfully traversed for the reason that Applicant had his invention in hand prior to the publication of either reference, Eady *et al* (1) or Eady *et al* (2).

Applicants submit herewith a declaration, prepared according to 37 C.F.R. § 1.131, from the inventor of the patent attesting to the fact that the present invention was developed prior to October 1, 1998, and therefore prior to the publications of Eady *et al* (1) and Eady *et al* (2).

As the Eady *et al* (1) and Eady *et al* (2) references are not a bar to patentability, withdrawal of the present rejection is respectfully requested.

As the application is believed to be in condition for allowance, Applicant requests early notification to that effect.

If the Examiner has any questions regarding this communication or feels that an interview might facilitate prosecution of the application, he is invited to contact the undersigned at (916) 444-3900.

Included with this communication is a fee in the amount of \$450.00 for an extension of time for a two-month to respond to the office action. Any additional fees required by this submission may be charged to deposit account 50-2767.

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Respectfully submitted,

By: 

Carl J. Schwedler, Reg. No.: 36,924  
McDonough Holland & Allen PC  
555 Capitol Mall, 9th Floor  
Sacramento, CA 95814-4692  
Tel.: (916) 444-3900  
Fax.: (916) 325-4587